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attorneys at law

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OCT 13 2004

Routing #393  
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**FAX COVER LETTER**

DATE: October 13, 2004

PLEASE DELIVER THE FOLLOWING PAGES:

TO: Mail Stop Issue Fee  
Examiner: Todd E. Manahan  
Art Unit: 3732

FAX: (703) 872-9306

FROM: K. Scott O'Brian

Direct Dial: (717) 237-5492

TOTAL NUMBER OF PAGES, INCLUDING THIS COVER LETTER: 12

**MESSAGE:**

Please acknowledge receipt of documents.

Transmittal Form  
Certificate of Fax Transmittal  
Correction of Inventorship (3 pages)  
Fee Transmittal (in duplicate)  
Newly signed declaration of Dr. Kim  
Newly signed declaration of original inventor, Teresa Hickok

Attorney Docket No.: 08563-0140  
Application No.: 10/067,155  
Filed: February 4, 2002

**FAX NUMBER: (717) 237-5300**

PARALEGAL RESPONSIBLE: Kimberly A. Newell

TELEPHONE: (717) 237-5239

**\*\*\*\*\*CONFIDENTIALITY NOTE\*\*\*\*\***

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PTO/SB/21 (02-04)

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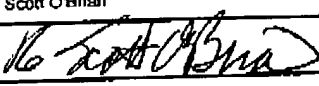
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>	Application Number	10/067,155	
	Filing Date	February 4, 2002	
	First Named Inventor	HICKOK et al.	
	Art Unit	3732	
	Examiner Name	MANAHAN, TODD E.	
Total Number of Pages in This Submission	12	Attorney Docket Number	08563-0140/1

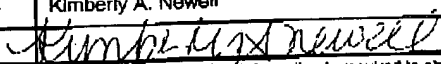
ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) ____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Certificate of Fax Transmittal Correction of Inventorship (3 pages); Newly signed Declaration of Dr. Kim and Teresa Hickok
Remarks		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	McNees Wallace & Nurick LLC K. Scott O'Brian
Signature	
Date	October 13, 2004

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Kimberly A. Newell	Date	October 13, 2004
Signature			

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (10-03)

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**FEE TRANSMITTAL  
for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 130**Complete If Known**

Application Number	10/067,155
Filing Date	February 4, 2002
First Named Inventor	HICKOK et al.
Examiner Name	MANAHAN, TODD E.
Art Unit	3732
Attorney Docket No.	Q8583-0140 (1)

**METHOD OF PAYMENT (check all that apply)**
☐ Check ☐ Credit card ☐ Money ☐ Other ☐ None  
Order
☒ Deposit Account:Deposit  
Account  
Number

50-1059

Deposit  
Account  
Name

McNees Wallace &amp; Nurick LLC

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments  
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☐ Charge fee(s) indicated below, except for the filing fee  
to the above-identified deposit account.
**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
		1001	770	2001	385	Utility filing fee	
		1002	340	2002	170	Design filing fee	
		1003	530	2003	265	Plant filing fee	
		1004	770	2004	385	Reissue filing fee	
		1005	160	2005	80	Provisional filing fee	

**SUBTOTAL (1)**

(\$0)

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims		Extra Claims		Fee from below		Fee Paid	
Independent Claims							
Multiple Dependent							

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
		1202	18	2202	9	Claims in excess of 20	
		1201	88	2201	43	Independent claims in excess of 3	
		1203	290	2203	145	Multiple dependent claim, if not paid	
		1204	88	2204	43	Reissue independent claims over original patent	
		1205	18	2205	9	Reissue claims in excess of 20 and over original patent	

**SUBTOTAL (2)**

(\$0)

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
		1051	130	2051	65	Surcharge - late filing fee or oath	
		1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
		1053	130	2053	130	Non-English specification	
		1812	2,520	1812	2,520	For filing a request for reexamination	
		1804	920	1804	920	Requesting publication of SIR prior to Examiner action	
		1805	1,840	1805	1,840	Requesting publication of SIR after Examiner action	
		1251	110	2251	55	Extension for reply within first month	
		1252	420	2252	210	Extension for reply within second month	
		1253	850	2253	475	Extension for reply within third month	
		1254	1,480	2254	740	Extension for reply within fourth month	
		1255	2,010	2255	1,005	Extension for reply within fifth month	
		1401	330	2401	165	Notice of Appeal	
		1402	330	2402	165	Filing a brief in support of an appeal	
		1403	290	2403	145	Request for oral hearing	
		1451	1,510	1451	1,510	Petition to Institute a public use proceeding	
		1452	110	2452	55	Petition to revive - unavoidable	
		1453	1,330	2453	665	Petition to revive - unintentional	
		1501	1,330	2501	665	Utility issue fee (or release)	
		1502	480	2502	240	Design issue fee	
		1503	640	2503	320	Plant issue fee	
		1450	130	1450	130	Petitions to the Commissioner	
		1807	50	1807	50	Processing fee under 37 CFR 1.17 (a)	
		1808	180	1808	180	Submission of Information Disclosure Stmt	
		8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
		1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
		1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
		1801	770	2801	385	Request for Continued Examination (RCE)	
		1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) Processing Fee under 37 CFR 1.17(l)

130.00

\*Reduced by Basic Filing Fee Paid

**SUBTOTAL (3)**

(\$130)

\*For number previously paid, if greater; For Reissues, see above

**SUBMITTED BY**

Name (Print/Type)

K. Scott O'Brian

Registration No.  
(Attorney/Agent)

42,946

Telephone

(717) 237-5492

Signature

Date

October 13, 2004

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PTO/SB/17 (10-03)

Approved for use through 07/31/2005. OMB 0651-0032

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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**FEE TRANSMITTAL  
for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT (\$)** 130**Complete If Known**

Application Number	10/067,155
Filing Date	February 4, 2002
First Named Inventor	HICKOK et al.
Examiner Name	MANAHAN, TODD E.
Art Unit	3732
Attorney Docket No.	08583-0140 (1)

**METHOD OF PAYMENT (check all that apply)**☐ Check ☐ Credit card ☐ Money ☐ Other ☐ None☒ Deposit Account:Deposit  
Account  
Number

50-1059

Deposit  
Account  
Name

McNees Wallace &amp; Nurick LLC

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments  
☐ Charge any additional fee(s) during the pendency of this application  
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.
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1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

**SUBTOTAL (1)**

(\$0)

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

		Extra Claims	Fee from below	Fee Paid
Total Claims		0	X	0
Independent Claims		0	X	0
Multiple Dependent			X	0

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	280	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

**SUBTOTAL (2)**

(\$0)

\*\*or number previously paid, if greater. For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Large Entity		Small Entity		Fee Description	Fee Paid
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1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (g)	
1808	180	1808	180	Submission of Information Disclosure Sheet	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
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130.00

\*Reduced by Basic Filing Fee Paid

**SUBTOTAL (3)**

(\$130)

**SUBMITTED BY**

Name (Print/Type)

K. Scott O'Brian

Registration No.  
(Attorney/Agent)

42,946

Telephone

(717) 237-5492

Signature

Date

October 13, 2004

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Attorney Docket No. 08563-0140  
Application No. 10/067,155

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**RECEIVED**  
**CENTRAL FAX CENTER**

In re Application of Teresa R. Hickok :  
: Group Art Unit: 3732  
Application No.: 10/067,155 :  
: Examiner: Manahan, Todd E.  
Application Filed: February 4, 2002 :

**OCT 13 2004**

For: MICROENDODONTICS ULTRASONIC SURGICAL DENTAL TOOL HAVING  
WATER PORT AND METHOD OF MAKING SAME

**CORRECTION OF INVENTORSHIP**

Mail Stop Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Applicant's attorney wishes to thank the Examiner for his assistance and patience in dealing with the correction of inventorship issue. In response to the Examiner's letter of September 20, 2004, provided are the following documents:

1. A newly signed declaration of Dr. Kim, who is added as inventor.
2. A newly signed declaration of the original inventor, Teresa Hickok.
3. The Fee under 37 CFR §1.17(i).

The below listed documents were previously provided to the Examiner and are not being resubmitted at this time, as they are included in the prosecution history..

4. Dr. Kim statement of facts by Dr. Kim;
5. An executed Consent of Assignee form.

Attorney Docket No. 08563-0140  
Application No. 10/067,155

6. An executed 3.73 statement by Assignee. Copies of all documents in the chain of title or cross reference to appropriate reel/frame number are provided.

Dr. Kim is added as a result of a Settlement Agreement in the lawsuit, Dentsply International, Inc. v. Earth City Technologies, Inc., United States District Court for the Eastern District of Missouri, Eastern Division (Case No.: 4:01CV00173HEA). During prosecution of the lawsuit, certain facts were brought to light to indicate that Dr. Kim is a co-inventor of the application as a result of contributions to at least one of the claims of the subject application made during the development of the invention by Ms. Hickok. Nevertheless, this omission was erroneous and without deceptive intent. The assignee of the application has thus acted to comply with 35 U.S.C. §116 and 37 CFR §1.48, to correct inventorship by providing the required declarations, chain of title and other documents to add Dr. Kim as the inventor.

The newly executed declarations include both named inventors on each executed declaration. The declarations were executed by the individual inventors at separate venues solely in an effort to expedite the filing of this response prior to the issuance of the patent. Based on prior discussions between assignee's attorney and the Examiner, these newly executed declarations should correct the informalities that precluded prior attempts to add Dr. Kim as an inventor.

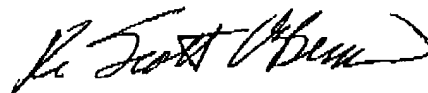
Authorization to charge any additional fees to Deposit account No. 50-1059 in connection with this filing is hereby provided. If any questions remain regarding the addition of Dr. Kim as an inventor, the U.S. Patent Office is requested to contact the undersigned.

Attorney Docket No. 08563-0140  
Application No. 10/067,155

**CONCLUSION**

The Commissioner is hereby authorized to charge indicated fees and any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,



K. Scott O'Brian  
Reg. No. 42,946

Dated: October 13, 2004

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Attorney for Applicant

ATTACHMENTS